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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,975	01/05/2001	Leonid Raiz	12116-002001	4739
26161	7590	08/22/2006	EXAMINER	
FISH & RICHARDSON PC			SONG, HOSUK	
P.O. BOX 1022			ART UNIT	
MINNEAPOLIS, MN 55440-1022			PAPER NUMBER	
			2135	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/755,975	RAIZ ET AL.	
	Examiner	Art Unit	
	Hosuk Song	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/1/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-7,11,13,16-18,20,22-24,27,29-30 remain rejected under 35 U.S.C. 102(e) as being anticipated by Colvin(US 6,044,471).

Claim 1: Colvin disclose distributing authorization keys from a subscription server to computers on which copies of an application program are stored and are to be run in (fig.1 and col.4,lines 6-19). Colvin discloses each of the authorization keys being associated with a validity period during which the authorization key will be valid and each authorization key allowing an application program to be operated during the validity in (fig.2,#84,86 and fig.3b #134). Colvin disclose at intermittent times that may be as infrequent as the times when the validity period ends,distributing new authorization keys to each of the computers in (col.2,lines 44-45). Colvin discloses the keys being distributed electronically in a manner that is transparent to users of the computers in (col.5,lines 36-45).

Claim 2: Colvin discloses new authorization keys are distributed in exchange for money in (col.4,lines 28-32).

Claim 4: Colvin discloses authorization key carries information about the validity period in (col.4 lines 2-4).

Art Unit: 2135

Claim 5: Colvin disclose new authorization keys are distributed by communication between the subscription server and each of the computers using a standard communication protocol on a publicly accessible communication network in (fig.1 and col.3,lines 1-2).

Claim 6: Colvin discloses validity period comprises a normal calendar period in (fig.1#46 and col.5,lines 36-39).

Claim 7: Colvin discloses validity period comprises a month in (fig.1#46 and col.5,lines 36-39).

Claim 11: Colvin discloses authorization key carries information about features of the application program that is enabled by the key in (col.6,lines 19-21).

Claim 13: Colvin discloses application program is distributed on a portable medium type or by a software download via the Internet in (fig.1).

Claim 16: Colvin discloses authorization keys are distributed in response to instructions given by a user interactively using a standard TCP/IP communication to the subscription server in (fig.1 and col.3,lines 50-59).

Claim 18: Colvin disclose application program may be used for a period as long as the validity period as long as the validity period while the computer on which it is running out of communication with the subscription server in (fig.1 and col.8,lines 15-18).

Claim 19: Colvin disclose users of the copies of the application programs are grouped within enterprises and the enterprise interacts with the subscription server to manage the number and duration of authorization keys that are distributed to its users and the payment for the authorization keys in (fig.1).

Claim 20: Colvin discloses authorization keys are stored on the user computers in (fig.1 and col.4,lines 18-26).

Claim 23: Colvin discloses user self-subscribes to the use of the application program without help of another person in (col.4,lines 33-46).

Art Unit: 2135

Claim 24: Colvin discloses subscription server comprises an Internet server using a standard TCP/IP protocol in (col.4,lines 55-60).

Claim 27: Colvin discloses at least one of the modes requires an authorization key in (col.7,lines 3-6).

Claim 29: Colvin discloses one of the modes comprises a subscription mode in (col.6,lines 26-36).

Claim 30: Colvin discloses one of the modes comprises full use of the application program and the authorization key is distributed in exchange for a payment in (col.6,lines 48-51).

Claims 3,17: Colvin disclose new authorization key is distributed automatically when an existing authorization key has reached the end of its validity period in (fig.3C).

Claim 22: Colvin disclose authorization key is encrypted in (fig.1#40 and col.3,lines 63-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-26,28,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin(US 6,044,471).

Claims 25,26,31: Colvin does not specifically disclose application program may be run in at least two different modes of use. Official notice is taken that application program run in at least two different modes of use is well known in the art. One of ordinary skill in the art would have been motivated to employ application to run in at least two different modes of use in order for user to try the program

Art Unit: 2135

first(trial version) before full purchase(full version) thus offering user preview of the software before making full financial commitment.

Claim 28: Colvin does not specifically disclose demonstration mode in which some features of the application program are disabled. Official notice is taken that demonstration mode is well known in the art. One of ordinary skill in the art would have been motivated to employ demonstration mode in order to attract customer to purchase full version of software.

3. Claims 10,12,14,15,21,32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin(US 6,044,471) in view of Wilde et al.(US 6,446,260).

Claims 10,12,14,15,21: Colvin does not specifically disclose authorization key carries information about the identity of a computer on which use of the application computer is authorized. Wilde discloses this limitation in (Col.11,lines 11-31). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ a key carries information about the identity of a computer on which use of the application computer is authorized as taught in Wilde with system of Colvin in order to deter hacker from using a program using a stolen key. Stolen key is useless unless it is employed in specific device according to key information thus enhancing security of its system.

Claims 32,34-37,43: Colvin discloses distributing without charge,copies of an application program online or on storage media for installation on one or more computers in (fig.3a). Colvin disclose enabling a user of one of he computers to choose among modes in which he wishes to run the application program in (fig.1). Colvin disclose in at least one of the chosen modes,enabling the user to run the application program without requiring the user to provide information about the user in (fig.2). Colvin does not specifically disclose authorization key carries information about the identity of a computer on which use of the application computer is authorized. Wilde discloses this limitation in (Col.11,lines 11-31). It would have been obvious to person of ordinary skill in the art at the time invention was made to employ a key carries information about the identity of a computer on which use of the application

Art Unit: 2135

computer is authorized as taught in Wilde with system of Colvin in order to deter hacker from using a program using a stolen key. Stolen key is useless unless it is employed in specific device according to key information thus enhancing security of its system. Clark disclose authorization key having a limited validity period in (col.21,lines 51-53).

Claim 33: Colvin does not specifically disclose demonstration mode in which some features of the application program are disabled. Official notice is taken that demonstration mode is well known in the art. One of ordinary skill in the art would have been motivated to employ demonstration mode in order to attract customer to purchase full version of software.

Claims 38: Colvin discloses application program is distributed on a portable medium or by a software download through the Internet in (fig.1).

Claim 39: Colvin discloses authorization keys are distributed in response to instructions given by a user interactively using a standard TCP/IP communication to the subscription server in (fig.1 and col.3,lines 50-59).

Claim 40: Colvin disclose application program may be used for a period as long as the validity period as long as the validity period while the computer on which it is running out of communication with the subscription server in (fig.1 and col.8,lines 15-18).

Claim 41: Colvin disclose users of the copies of the application programs are grouped within enterprises and the enterprise interacts with the subscription server to manage the number and duration of authorization keys that are distributed to its users and the payment for the authorization keys in (fig.1).

Claim 42: Colvin discloses authorization keys are stored on the user computers in (fig.1 and col.4,lines 18-26).

4. Claims 8,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvin(US 6,044,471) in view of Brandt et al.(US 5,758,068).

Art Unit: 2135

Claims 8-9: Colvin does not specifically disclose when a validity period lapses, automatically providing a grace period based on information contained in the authorization key, the grace period permitting continued running of the application program. Brandt's patent discloses this limitation in (col.2,lines 16-19;col.3,lines 26-28). It would have been obvious to person of ordinary skill in the art at the time invention was made to provide grace period when a validity period lapses as taught in Brandt with system disclosed in Colvin in order to continuously provide service to the subscriber without service interruption thus providing convenient and user friendly environment to the subscriber.

Response to Arguments

5. Previous grounds of rejection based on the Clark patent is withdrawn. However, newly discovered prior art has necessitated a new grounds of rejection.

USPTO Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HS



Hosuk Song
Primary Examiner
Art Unit 2135